



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,317	01/14/2004	Mary Jo Winterer	AP35651 - 070457.1675	3521
21003 7590 11/05/2008 BAKER BOTTS L.L.P. 30 ROCKEFELLER PLAZA 44TH FLOOR NEW YORK, NY 10112-4498				
EXAMINER LIU, CHIA-YI				
ART UNIT 3696		PAPER NUMBER		
NOTIFICATION DATE 11/05/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DLNYDOCKET@BAKERBOTTS.COM

Office Action Summary

Application No.

10/757,317

Applicant(s)

WINTERER ET AL.

Examiner

CHIA-YI LIU

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5 and 7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 3-5, 7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/CDC)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

Claims 1, 3-5 and 7 are presented for examination. Applicant filed a response (RCE) on 10/24/2008, amending independent claims 1 and 5. New grounds of rejections necessitated by applicant's amendments are set forth in detail below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, independent Claims 1 and 5 teach the limitations "incurring charges associated with each such transaction," and "automatically deducting an amount equal to the total amount of said charges." It is unclear whether "the total amount of said charges" refers to the total amount of a single transaction or the total amount of multiple transactions. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bucci (US 6,786,400) in view of Konya (5,937,396) further in view of Kobayashi (US 2002/0083011 A1) and further in view of Official Notice (as evidenced by in re Venner, 120 USPO 192, 194; 262 F2d 91 (CCPA 1958)).

As per Claims 1, 5

Bucci ('400) discloses,

a consumer depository account (checking account) maintained by a first (second) financial institution holding funds on behalf of said consumer, see Fig 3 (345, 350) and column 2, lines 6-9.

a payment card (multifunctional card) for conducting two or more transactions and incurring charges associated with each such transaction, said card being issued to said consumer by a second (first) financial institution, see column 2, lines 2- 9. (conduct at least one transaction/conduct at least one other transaction = two or more transactions)

said card further being linked to said depository account (checking account) maintained at said first institution for covering said charges, see column 2, lines 6-14 and column 4, lines 20-23.

Bucci ('400) does not specifically disclose automatically deducting from said depository account periodically an amount equal to the total amount of said charges. Konya ('396) teaches the amount of the transaction is deducted from depository account, see column 1, lines 37-41. Kobayashi ('011) teaches transaction amount is deducted from bank account of the purchaser on a monthly or a transaction basis, see paragraph 0130. Official Notice is taken that is it old and well known in the art to make a manual process automatic. (see in re Venner, 120 USPO 192, 194; 262 F2d 91 (CCPA 1958). Bucci, Konya and Kobayashi are all directed toward transferring funds from accounts. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include automatically deducting from said depository account periodically an amount equal to the total amount of said charges. One of the ordinary skill in the art would be motivated to do so, for the benefit of saving time and preventing late payment.

As per Claims 3, 7

Bucci ('400) further discloses a credit limit is associated with said card, which

limit is reduced based on said charges, and refreshed automatically as a function of said deducting means, see column 11, lines 4-5. (It is inherent that credit card has a credit limit and the limit (the amount you are allowed to spend) is reduced every time you use it to purchase something. It is also inherent that credit card limit is refreshed automatically every month)

Claims 4, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bucci (US 6,786,400) in view of Konya (5,927,396), Kobayashi (US 2002/0083911 A1) and further in view of Official Notice, as applied to Claims 1 and 5 above, and further in view of Weissman (US 6,353,811)

As per Claims 4, 8

Bucci ('400) does not specifically disclose billing means operated by said second financial institution for periodically informing said consumer of said charges made on the card and of the amount received from said consumer depository account to cover said charges. Weissman ('811) teaches billing means (billing statement) operated by said second financial institution for periodically informing said consumer of said charges made on the card and of the amount received from said consumer depository account to cover said charges, see Abstract of Weissman (lines 17-22) and Fig 2A. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include billing means operated by said second financial institution for periodically informing said consumer of said charges made on the card and of the amount received from said consumer depository account to cover said charges. One of ordinary in the skill would be motivated to do so, for the benefit of allowing customers to keep track of the balance and avoiding over-spending.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHIA-YI LIU whose telephone number is (571)270-1573. The examiner can normally be reached on Mon-Thur alternating Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TOM DIXON can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THOMAS A DIXON/
Supervisory Patent Examiner, Art Unit 3696

CHIA-YI LIU
Examiner
Art Unit 3696